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**Datasheet for the interlocutory decision
of 24 June 2024**

Case Number: T 0439/22 - 3.2.01

Application Number: 14806330.8

Publication Number: 3076804

IPC: A24D1/00, A24F47/00

Language of the proceedings: EN

Title of invention:

HEATED AEROSOL GENERATING ARTICLE WITH THERMAL SPREADING WRAP

Patent Proprietor:

Philip Morris Products S.A.

Opponent:

Yunnan Tobacco International Co., Ltd.

Headword:

Gathered sheet

Relevant legal provisions:

EPC Art. 52(1), 54, 56, 69(1), 112(1)(a)

Keyword:

Referral to the Enlarged Board of Appeal
Claims interpretation

Decisions cited:

G 0002/88, G 0006/88, G 0002/98, G 0001/03, G 0002/10,
J 0016/96, T 0016/87, T 0416/87, T 0969/92, T 0311/93,
T 0312/94, T 0190/99, T 0523/00, T 0500/01, T 0556/02,
T 1279/04, T 1321/04, T 0843/06, T 1374/06, T 1736/06,
T 0964/07, T 0374/08, T 0620/08, T 0768/08, T 0299/09,
T 0467/09, T 0478/09, T 0494/09, T 0522/09, T 1593/09,
T 1671/09, T 1871/09, T 0197/10, T 0275/10, T 2097/10,
T 0295/11, T 2589/11, T 0552/12, T 1597/12, T 1646/12,
T 0058/13, T 0580/13, T 1267/13, T 0145/14, T 1385/14,
T 1391/15, T 2196/15, T 2344/15, T 0978/16, T 1116/16,
T 1127/16, T 1169/16, T 1283/16, T 2601/16, T 0030/17,
T 1705/17, T 1292/17, T 2600/17, T 2684/17, T 0353/18,
T 0911/18, T 1648/18, T 2319/18, T 2773/18, T 0073/19,
T 1266/19, T 1300/19, T 1473/19, T 1695/19, T 1735/19,
T 1844/19, T 2548/19, T 2764/19, T 0169/20, T 0278/20,
T 0367/20, T 0427/20, T 0450/20, T 0503/20, T 0694/20,
T 0821/20, T 1171/20, T 1382/20, T 1924/20, T 0918/21,
T 0470/21, T 1260/21, T 1266/21, T 1335/21, T 1494/21,
T 1527/21, T 1628/21, T 1632/21, T 0042/22, T 0447/22,
T 0111/22, T 0177/22, T 0675/22, T 0953/22

France :

Tribunal de grande instance (TGI) de Paris:

TGI Paris, 02.07.2015, N° RG 12/11488
TGI Paris, 14.04.2016, N° RG 14/11998
TGI Paris, 20.04.2017, N° RG 14/05016
TGI Paris, 16.11.2017, N° RG14/14922

Tribunal judiciaire (TJ) de Paris:

TJ Paris, 24.03.2023, N° RG 20/03907

Cour d'appel (CA) de Paris :

CA Paris, 19 October 2021, N RG 17/22624)

United Kingdom :

House of Lords (UKHL) :

Kirin Amgen Inc v Hoechst Marion Roussel Ltd [2004] UKHL 46,
[2005] RPC 9, 21 October 2004, 21 October 2004

England and Wales Court of Appeal (EWCA):

Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd [2009] EWCA Civ 1062, 22 October 2009

European Central Bank v DSS [2008] EWCA Civ 192, 19 March 2008

England and Wales High Court (EWHC)

McGhan Medical UK Ltd v Nagor Ltd and Biosil Ltd [2001] EWHC Patents 452, 28 February 2001

Samsung Electronics Co. Ltd v Apple Retail UK Ltd & Anor [2013] EWHC 467 (Pat), 7 March 2013

Germany:

Bundesgerichtshof (BGH):

BGH, Urt. v. 02.03.1999 - X ZR 85/96 - Spannschraube

BGH, Urt. v. 12.12.2006 - X ZR 131/02 - Schussfädentransport

BGH Urt. v. 29.06.2010 - X ZR 193/03 - BGHZ 186, 90 - Crimpwerkzeug III

BGH, Urt. v. 12.05.2015 - X ZR 43/13 - Rotorelemente

BGH, Urt. v. 07.07.2015 - X ZR 64/13 - Bitratenreduktion

Unified Patent Court:

Court of Appeal of the Unified Patent Court (CoA UPC):

Nanostring v 10x Genomics, UPC_CoA_335/2023, App_576355/2023 of 26 February 2024

VusionGroup v Hanshow (APL_ 8/2024, ORD_17447/2024) of 13 May 2024

Catchword:

The following questions are referred to the Enlarged Board of Appeal, both to ensure the uniform application of the law [see point 3] and because a point of law of fundamental importance arises [see point 4]:

1. Is Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC? [see points 3.2, 4.2 and 6.1]
2. May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation? [see points 3.3, 4.3 and 6.2]
3. May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions? [see points 3.4, 4.4 and 6.3]



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Case Number: T 0439/22 - 3.2.01

I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal 3.2.01
of 24 June 2024

Appellant: Yunnan Tobacco International Co., Ltd.
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Respondent: Philip Morris Products S.A.
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Representative: HGF
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 December
2021 rejecting the opposition filed against
European patent No. 3076804 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
P. Guntz

Summary of Facts and Submissions

I. The appeal lies against the decision of the Opposition Division rejecting the opposition filed against European patent No. 2 307 6804.

Independent claim 1 as granted reads as follows (labelling of the features according to the appealed decision):

"(a) A heated aerosol-generating article for use with an electrically-operated aerosol generating device comprising a heating element,

(b) the aerosol-generating article comprising an aerosol-forming substrate

(c) in which the aerosol-forming substrate comprises a gathered sheet of aerosol-forming material circumscribed by a wrapper

(d) radially encircled by a sheet of thermally-conductive material, the wrapper being the sheet of thermally-conductive material which acts as a thermally conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying a flame to the aerosol generating article."

In its decision, the Opposition Division found that the only ground for opposition raised by the opponent under Article 100(a) EPC in combination with Articles 54 and 56 EPC was not prejudicial to the maintenance of the patent as granted and hence rejected the opposition. Novelty and inventive step were positively assessed in

view of the following prior-art documents:

D1: EP 2 368 449 A1
D2: WO 2011 117750 A
D3: WO 2012 164009 A
D4: WO 2013 098405 A

In the novelty assessment by the Opposition Division, the only question at issue was whether an aerosol-forming substrate comprising a *"gathered sheet"* according to feature (c) of claim 1 as granted was directly and unambiguously derivable from documents D1 and D2 which indisputably disclosed the remaining features of the independent claim. Decisive for the finding that the subject-matter as granted was novel over the disclosure of these prior-art documents was the view of the Opposition Division that the term *"gathered sheet"* had a clear and agreed meaning widely adopted in the tobacco industry. This term did thus not require interpretation in light of the description which - as pointed out by the opponent - provided in paragraph [0035] an explicit and broader definition of the term *"gathered sheet"* in the technical context of the patent, allegedly encompassing a rolled/wound tobacco sheet and a cylindrical plug of homogenised tobacco material as disclosed in D1 and D2 respectively.

II. With a communication in accordance with Article 15(1) RPBA dated 5 December 2023, the Board informed the parties that the outcome of the case appeared to hinge on whether the description was to be taken into account even when interpreting a claim that contained an allegedly clear term. In its communication, the Board identified diverging lines of case law on that issue (by way of example, reference was made to the

conclusions of the decisions T 1473/19 and T 169/20) and considered that the matter was of fundamental importance for the interpretation of the EPC by the European Patent Office and national and multinational courts and that it needed to be resolved for the case to be decided. Thus, the Board indicated that it intended to refer questions to the Enlarged Board of Appeal.

With the letter dated 18 December 2023, the appellant (opponent) welcomed the proposal of the Board to refer the question of claim interpretation to the Enlarged Board of Appeal and withdrew its request for oral proceedings.

With the letter dated 5 January 2024, the respondent (patent proprietor) expressed the view that the cases referred to in the communication of the Board did not represent a clear divergence between different boards to an extent that a referral to the Enlarged Board of Appeal was required or necessary to deal with the matter in hand, maintaining its request for oral proceedings.

Oral proceedings took place before the Board on 10 April 2024 by videoconference.

III. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed.

IV. The submissions of the appellant (opponent) relevant for the present decision can be summarised as follows.

At the oral proceedings, the appellant conceded that although the term "*gathered sheet*" did not have a clear and agreed meaning as held by the Opposition Division in the decision under appeal, the skilled person when reading the claim in isolation from the description of the patent in suit would assume that a "*gathered sheet*" was provided with folds. Thus, an evenly wound sheet as shown in D1 would not be encompassed. However, the description of the patent provided, in paragraph [0035], a definition of what had to be understood by a "*gathered [tobacco] sheet*" in the patent, namely a sheet of tobacco material that was "*convoluted, folded, or otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod*". This definition made technical sense and did not contradict any established meaning in the art. It clearly encompassed the wound tobacco sheet of D1. Accordingly, document D1 was prejudicial to the novelty of claim 1 as granted.

Pursuant to Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC, the description and thus in particular paragraph [0035] had to be taken into account when construing the claims.

This was in accordance with one line of case law (see, for example, T 1473/19, T 0620/08, T 0367/20 or T 1671/09) and also with the approach commonly adopted by several national patent offices and also recently followed by the Unified Patent Court in its decision 335/2023.

On the other hand, according to the approach based on

the primacy of the claims (see T 169/20) apparently adopted by the Opposition Division in its decision, the support of the description for interpreting the claims was restricted to exceptional cases where the claimed subject-matter needed to be clarified. Conversely, when the wording of a claim was clear for the skilled person, the supporting role of the description was deemed neither necessary nor justified under this line of case law.

If lack of novelty over D1 could not be acknowledged, it would be appropriate to refer questions to the Enlarged Board of Appeal to ensure the uniform application of the law on claim interpretation.

V. The respondent's reply to these submissions can be summarised as follows.

As pointed out by the Opposition Division in the impugned decision, the term *"gathered sheet"* had a clear and widely agreed meaning in the tobacco industry, namely a sheet which was *"folded and convoluted to occupy a tri-dimensional space"*. Accordingly, there was no need to consult the description to interpret this term. In any case, even if paragraph [0035] of the description were to be taken into account, the rolled sheet of tobacco of D1 formed by winding could still not be regarded as being *"convoluted"* or *"otherwise compressed or constricted substantially transversely"* as it was hollow, had a defined geometrical shape and as such did not require compression or constriction to maintain its shape. Moreover, a rolled sheet according to D1 had to be ruled out when considering the embodiment described in the patent in connection with Figure 1. Furthermore, an aerosol-forming substrate manufactured as a

cylindrically rolled sheet would not solve the technical problem addressed by the contested patent. Additionally, if a rolled aerosol-forming substrate was used in the heated aerosol-generating article according to the contested patent, this could not be promptly distinguishable from a conventional cigarette with the risk that the user could mistakenly ignite the aerosol-forming substrate.

There was consensus within the boards on the principle of the *"primacy of the claims"*, which was consistently applied to determine the actual extent of the protection afforded by the claims. T 169/20 (Reasons 1.4), T 1924/20 (Reasons 2.7) and T 111/22 (Reasons 1.8 and 1.9) consistently supported an interpretation of the claims on their own merit, at least when a term in the claims had a generally recognised meaning. In decision T 1473/19, the board stated that *"[t]he primacy of the claims therefore also limits the extent to which the description may serve as a dictionary for the terms used in the claims"* (see Reasons 3.16.2), this underscoring the predominance of the wording of the claims when the text at issue was clear and unambiguous for a skilled reader as allegedly in the case at hand. In T 1671/09 (Reasons 3.3), it was considered legitimate to resort to the description but only to reach a better understanding of a term of the claim, namely *"dots"*, which, in itself, was not particularly precise and unambiguous. In fact, there were no clear divergent lines of case law on the interpretation of a clear and unambiguous term contained in a claim.

It was therefore not justified to refer questions to the Enlarged Board of Appeal.

Reasons for the Decision

Novelty over D1

1. With its appeal, the appellant contested the conclusion of the Opposition Division that the subject-matter of claim 1 as granted was novel over document D1.

1.1 The parties agreed that D1 discloses a heated aerosol-generating article (see paragraphs [0005] and [0014]) for use with an electrically operated aerosol-generating device comprising a heating element (heater, see paragraphs [0006] and [0013]), the aerosol-generating article comprising an aerosol-forming substrate (tobacco sheet 21, see paragraph [0022]), in which the aerosol-forming substrate comprises a sheet (tobacco sheet 21) of aerosol-forming material (tobacco) circumscribed by a wrapper (22, see paragraphs [0007] and [0014]), radially encircled by a sheet of thermally conductive material, the wrapper being the sheet of thermally conductive material which acts as a thermally conducting flame barrier for spreading heat and mitigating against the risk of a user igniting the aerosol-forming substrate by applying a flame to the aerosol-generating article (see paragraph [0015]).

D1 discloses, as shown in Figure 1, an aerosol-generating article in the form of a roll 20 intended to be uniformly heated by the inside surface of a heater 11 having the shape of a hollow cylinder (see paragraph [0020]). According to the teaching of D1, the roll 20 comprises a tobacco sheet 21 which *"may be wound as a single or multiple layers. In this case, only the tobacco sheet 21 may be spirally wound or a laminate of*

the tobacco sheet 21 and aluminum foil may be spirally wound" (see paragraph [0018]).

It is also not disputed that a tobacco sheet spirally wound as in D1 would not be seen as a *"gathered sheet"* when this term was understood as requiring that the sheet be both *"folded and convoluted"*.

As an example, in the embodiment disclosed in the patent in suit (see paragraphs [0064] and [0065] and Figure 1), a continuous sheet of tobacco is fed to an apparatus where it is engaged by crimping rollers to form a continuous crimped sheet having a plurality of spaced-apart ridges or corrugations parallel to the longitudinal axis of the sheet through the apparatus and then fed through a converging funnel which gathers the continuous sheet transversely relative to its longitudinal axes. The tobacco sheet assumes a substantially cylindrical configuration as it passes through the converging funnel. The resulting tobacco sheet is thus provided with folds and occupies a tridimensional space.

In agreement with the contested decision, the Board takes the view that a skilled person in the current technical field would understand the term *"gathered sheet"*, when read in isolation, as defining a sheet folded along lines to occupy a tridimensional space.

Accordingly, when assigning to *"gathered sheet"* this usual meaning, the subject-matter of claim 1 must be regarded as novel in view of the distinguishing feature that the aerosol-forming substrate comprises a gathered sheet of aerosol-forming material. In fact, novelty under this assumption was not contested by the

appellant.

- 1.2 However, while the method set out above seems to be the typical way to form gathered sheets in the tobacco industry, there may be other ways to gather flat tobacco sheets to give them the form of a cylindrical rod.

The fact that the patent apparently saw the necessity to define the term (see paragraph [0035] of the description) is an indication that, at least for the patent proprietor when drafting the application, *"gathered sheet"* did not have a meaning that is so generally accepted and well established that each explanation would be moot.

The fact that *"crimped/creped sheets"*, i.e. sheets having a plurality of substantially parallel ridges or corrugations (see paragraph [0039]) are described as being only one form of a *"textured sheet"* (see paragraph [0038]) and the further fact that the use of a textured sheet is only optional when producing *"gathered sheets"* (see paragraph [0037]) are further indications that, at least for the drafter of the patent application, the latter term did not have such a fixed meaning as now suggested by the respondent.

- 1.3 Thus, if, as argued by the appellant, the term *"gathered sheet"* in claim 1 cannot be read in isolation but should be construed in light of the description (in particular, paragraph [0035]: *"As used herein, the term 'gathered' denotes that the sheet of tobacco material is convoluted, folded, or otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod"*), the term would have a broader meaning which, however, still makes technical

sense and is not in contradiction with but merely encompasses the usual meaning in the art.

The Board concurs with the appellant that if the term "*gathered sheet*" is read in light of this definition and the following paragraphs as cited above, the subject-matter of claim 1 lacks novelty. Paragraph [0035] refers to various alternatives. According to the first one, the gathered sheet may be a convoluted sheet. The definition of the term "*convoluted*" in the *Oxford Dictionary*, referred to by the appellant in the statement of grounds of appeal, includes "*coiled*". The spirally wound tobacco sheet disclosed in D1 (see paragraph [0018]) is also coiled around its axis and is therefore "*convoluted*" and hence may be regarded as a gathered sheet according to the explicit definition given in the description. The third and fourth alternatives of a gathered sheet presented in paragraph [0035] of the patent, namely a sheet which is "*otherwise compressed or constricted substantially transversely to the cylindrical axis of the rod*", are also fulfilled by the wound tobacco sheet of D1. In fact, when a sheet is wound to assume a cylindrical shape, it is also compressed in some manner and certainly constricted substantially transversally to the axis of a cylinder. This is irrespective of whether the final shape of the product is hollow.

Furthermore, there is no reason to rule out a wound sheet when considering the embodiment of the patent shown in Figure 1 since the definition of paragraph [0035] does not contradict but rather encompasses the embodiment in which the sheet is crimped along lines and gathered when passing through the funnel. However, as "*folded*" is only one of four alternatives in this definition, the presence of folds can no longer be seen

as mandatory.

Finally, the respondent's submissions that an aerosol-forming substrate manufactured as a cylindrically wound sheet would not solve the technical problem addressed by the contested patent and that if such a substrate were used in the heated aerosol-generating article according to the contested patent this could not be promptly distinguishable from a conventional cigarette with the risk that the user could mistakenly ignite the aerosol-forming substrate are not convincing. There is no apparent reason for a skilled person to rule out, either reading the claim alone or along with the description and drawings, an aerosol-forming substrate obtained by winding a tobacco sheet which has a cylindrical, potentially hollow, shape as in D1. In the embodiment of Figure 5 of the patent, a heating element (heating blade 3100, see paragraph [0076]) is provided for heating the substrate from within, as in D1.

- 1.4 In conclusion, if the term "*gathered sheet*" in claim 1 is given its usual meaning in the art, the subject-matter of claim 1 is novel, whereas if the same term is read in a broader but still technically meaningful manner in view of the definition in paragraph [0035] of the description, the subject-matter of claim 1 lacks novelty.

Referral to the Enlarged Board of Appeal

2. Under Article 112(1)(a) EPC, a board must, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer questions of law to the Enlarged Board of Appeal if it considers that a decision of the Enlarged Board is required to ensure the uniform application of the law

or if it considers that a point of law of fundamental importance arises that needs clarification.

As to the admissibility of a referral, it is generally considered necessary that the decision of the Enlarged Board on questions referred to it be decisive for the outcome of the referral case. In accordance with J 16/90 (see Reasons 1.2), it is not sufficient for the point referred to be of general interest, an answer to it must also be necessary to come to a decision on the appeal in question. A board is thus obliged, before making the referral, to consider whether it cannot leave open the question on the grounds that the appeal would have to be dismissed for other reasons.

The current Board has made such considerations in view of the fact that the decision under appeal deals with objections of lack of novelty over D2 and lack of inventive step starting from any of D1, D2, D3 and D4 and that these objections are maintained in appeal. However, the Board considers that a meaningful discussion on novelty over D2, the disclosure of which is analogous to D1, and inventive step cannot be carried out before determining how the claim - namely the term "*gathered sheet*" - should be construed.

3. A decision of the Enlarged Board is required to ensure the uniform application of the law.

3.1 The case law of the boards is divergent on the following questions, which are all decisive for the case at hand:

- legal basis for construing patent claims

- whether it is a prerequisite for taking the figures and description into account when construing a patent claim that the claim wording when read in isolation be found to be unclear or ambiguous
- extent to which a patent can serve as its own dictionary

These questions are interrelated but not dependent on each other, as is shown below.

All three points, for which there is divergence in the case law, need to be clarified to allow for a decision in the current case.

3.2 As regards the legal basis, there seemed to be no doubt in the early years that Article 69 EPC and the Protocol on the Interpretation of Article 69 EPC were to be applied not only when assessing Article 123(3) EPC (see G 2/88, Reasons 2.5) but also when assessing the prerequisites of patentability, such as Article 54 EPC (see G 6/88, Reasons 3; T 16/87, Reasons 6).

3.2.1 However, over the years, a strong line of case law has developed that took G 2/88 as an indication that Article 69 EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC should, within the jurisdiction of the European Patent Organisation, exclusively be applied in the realm of Article 123(3) EPC that refers to the patent's scope of protection, while in the realm of provisions dealing with the invention, such as Articles 54, 56 and 83 EPC, or with the patent/patent application, such as Article 123(2) EPC, these provisions should not be applicable. The fact that G 6/88 was issued on the same day and that the Enlarged Board of Appeal did not make this

distinction in either of these decisions seems to have been lost over the years.

Of the 100 decisions found to deal with claim interpretation since 2008 (19 being appeals against decisions of examining divisions and 81 being opposition appeals), a majority of 52 decisions (14 examining appeal decisions and 38 opposition appeal decisions) fall into this category. While often no alternative legal basis is indicated, sporadically Article 84 EPC is referred to as an adequate basis for interpretation (see e.g. T 169/20, Reasons 1.2.5 to 1.2.7).

3.2.2 In contrast, there has always been another line of case law postulating that Article 69 EPC and its protocol provide the only basis for construing claims in the EPC and should therefore be applied over the whole realm of the EPC. The "invention" within the meaning of Article 54(1) EPC, the "invention" within the meaning of Article 56 EPC and the "invention" within the meaning of Article 100(b) EPC (and Article 83 EPC) all referring to the claimed subject-matter, a given patent claim's subject-matter must be interpreted and determined in a uniform and consistent manner (see e.g. T 1473/19, Reasons 3.8 to 3.15; T 177/22, Reasons 3.2). Two examination cases and 24 opposition cases fall into this category, while the 22 remaining cases do not specify the legal basis for the claim interpretation.

In fact, Article 69(1), second sentence (*"Nevertheless, the description and drawings shall be used to interpret the claims"*) seems to be the only passage in the EPC where claim construction is mentioned. Since the patent claims define not only the extent of protection given by a granted patent (Article

69(1) EPC, first sentence) but also the invention for which patents giving these rights (Article 64 EPC) are granted if the invention is found patentable (Article 52 EPC ff) or, as Article 84 EPC puts it, "the matter for which protection is sought", a need arises to interpret the requested claims before being able to assess whether the invention defined by these claims is new or already disclosed in the state of the art (Article 54 EPC) and whether it involves an inventive step or is obvious having regard to the state of the art (Article 56 EPC).

- 3.2.3 This seems to be what the Enlarged Board of Appeal had in mind when holding in G 6/88 (see Reasons 2.4, 2.5 and 3):

"the requirements for drafting claims in respect of inventions which are the subject of European patent applications and patents, and the patentability of such inventions, are all matters which must be decided upon the basis of the law under the EPC. The function of the claims is central to the operation of the European patent system.

Article 84 EPC provides that the claims of a European patent application "shall define the matter for which protection is sought". Rule 29(1) EPC [1973, corresponds to Rule 43 EPC 2000] further requires that the claims "shall define the matter for which protection is sought in terms of the technical features of the invention". The primary aim of the wording used in a claim must therefore be to satisfy such requirements, having regard to the particular nature of the subject invention, and having regard also to the purpose of such claims. The purpose of claims under the EPC is to enable the protection conferred by the patent

(or patent application) to be determined (Article 69 EPC), and thus the rights of the patent owner within the designated Contracting States (Article 64 EPC), having regard to the patentability requirements of Articles 52 to 57 EPC. ...

For the purpose of determining their technical features, the claims must be interpreted in accordance with Article 69(1) EPC and its Protocol. The Protocol was adopted by the Contracting States as an integral part of the EPC in order to provide a mechanism for harmonisation of the various national approaches to the drafting and interpretation of claims... The object of the Protocol is clearly to avoid too much emphasis on the literal wording of the claims when considered in isolation from the remainder of the text of the patent in which they appear; and also to avoid too much emphasis upon the general inventive concept disclosed in the text of the patent as compared to the relevant prior art, without sufficient regard also to the wording of the claims as a means of definition."

The Enlarged Board, thus, clearly regarded Article 69 EPC and the protocol on its interpretation as the relevant means of determining the technical features of a claim, expressly both in assessing patentability when comparing the invention with the relevant prior art and for the scope of protection when determining which rights are conferred by the patent (or patent application). Thus, it can hardly be assumed that the Enlarged Board of Appeal would have agreed with the development of diverging standards for assessing these two sides of the same coin, particularly given that the Enlarged Board always strove for consistency in its assessment of similar principles found across different provisions of the EPC (see e.g. "the uniform concept of

disclosure" with reference to Articles 54, 87 and 123 EPC as developed in decisions G 2/98, Reasons 9; G 1/03, Reasons 2.2.2 and G 2/10, Reasons 4.6).

However, none of the boards developing the case law on the inapplicability of Article 69 EPC in the assessment of patentability appeared to recognise a deviation of the interpretation of the Convention contained in G 6/88 and referred the question to the Enlarged Board of Appeal as provided for in Article 21 of the Rules of Procedure of the Boards of Appeal (then Article 16 RPBA, see OJ EPO 1983, 7).

Thus, to reach a common approach on the legal basis for claim construction for patentability, a referral of the case to the Enlarged Board of Appeal is required.

3.3 Another legal principle often found in the case law of the boards is that the description may, if at all, only be taken into consideration for construing a claim if the wording of the claim when read on its own remains unclear or ambiguous.

3.3.1 This principle is often linked to the principle of inapplicability of Article 69 EPC for the assessment of patentability (see T 278/20, Reasons; T 169/20, Reasons 1.2.5; T 1735/19, Reasons 2.3; T 353/18, Reasons 2.4.5; T 978/16, Reasons 2.3 and 2.4; T 2601/16, Reasons 2.3.2; T 1292/17, Reasons 1.3; T 1705/17, Reasons 1.2; T 2600/17, Reasons 2.4; T 30/17, Reasons 2.1.7; T 2344/15, Reasons 1.8; T 1391/15, Reasons 3.5; T 1267/13, Reasons 4.1; T 580/13, Reasons 2; T 145/14, Reasons 2.2.6; T 1597/12, Reasons 3.2; T 1593/09, Reasons 4.1; T 295/11, Reasons 4.1.4; T 467/09, Reasons 2; T 494/09, Reasons 5; T 964/07, Reasons 2.1.2; T

1374/06, Reasons 4.1; T 843/06, Reasons 4.4).

3.3.2 However, this link is not inevitable:

(a) The principle may also be found in decisions that apply Article 69 EPC (see e.g. T 1695/19, Reasons 2.2.4; T 1300/19, Reasons 1.3.3; T 58/13, Reasons 3.2; T 2097/10, Reasons 4.3; T 1671/09, Reasons 3.3) or do not indicate any legal basis (T 42/22, Reasons 3.1 to 3.4; T 1527/21, Reasons 2.2.1; T 821/20, Reasons 1.7; T 427/20, Reasons 5.3; T 1648/18, Reasons 1.3; T 1385/14, Reasons 4.3; T 197/10, Reasons 2.3).

(b) Moreover, there are decisions where the need to always read the terms used in a claim in the context of the claims as a whole and of the description is emphasised, although Article 69 EPC is not held to be applicable for assessing patentability (see e.g. T 2684/17, Reasons 2.1.4; T 1283/16, Reasons 4; T 2196/15, Reasons 1.1; T 1871/09, Reasons 3.1; T 1646/12, Reasons 2.1; T 620/08, Reasons 3.8., 3.16 and 3.17) or is not referred to as the legal basis for taking the patent as a unitary document into consideration (see e.g. T 447/22, Reasons 13.1).

Thus, the question whether ambiguity in the claim is a prerequisite for taking the description and figures into consideration arises independently of the question whether Article 69 EPC and the protocol are applicable.

3.3.3 Most decisions that apply Article 69 EPC take the description and figures into consideration in any case when construing the claim (see e.g. T 177/22, Reasons 2.2.7 and T 918/21, Reasons 1.3 to 1.6.4) but, as a

second step, often give priority to the wording of the claim in case of divergence with information only found in the description (see e.g. T 1473/19, Reasons 3.1 to 3.15 and Reasons 3.16 to 3.16.2, and also T 1335/21, Reasons 1.9; T 367/20, Reasons 1.3.3 to 1.3.6; T 1632/21, Reasons 4.2; T 1171/20, Reasons 6; T 450/20, Reasons 2.6 and 2.15; T 1494/21, Reasons 2.6 and 2.14; T 2319/18, Reasons 12; T 1844/19, Reasons 1.5; T 73/19, Reasons 2.2; T 1116/16, Reasons; T 552/12, Reasons 3.6; T 275/10, Reasons 2.3; T 1671/09, Reasons 3.3 and 3.4; T 522/09, Reasons 2.3; T 374/08, Reasons 2.2.2).

3.3.4 Other decisions take the description into consideration irrespective of any ambiguity detected, either without indicating a legal basis (see T 953/22, Reasons 2; T 111/22, Reasons 1.9; T 1382/20, Reasons 4.6; T 2773/18, Reasons 2.3; T 1648/18, Reasons 1.3; T 1169/16, Reasons 2.1; T 478/09, Reasons 6c) or in cases where the contentious question did not need to be decided upon, e.g. because the claim language was found to be ambiguous (see T 694/20, Reasons 4.1).

3.3.5 Still other decisions leave the question unanswered because, even when applying Article 69, limiting features should not be read into the claim (T 1628/21, Reasons 1.1.9; T 503/20, Reasons 3.2; T 1260/21, Reasons 1.2.2; T 2548/19, Reasons 6; T 911/18, Reasons 4.3; T 299/09, Reasons 3.3.1; T 1736/06, Reasons 2.2) and existing features in a claim should not be disregarded with reference to information given only in the description (see T 1266/21, Reasons 2.3.4).

Similar considerations can be found, without referring to the question of the legal basis, in decision T 1266/19, Reasons 11.4.

- 3.3.6 Finally, some decisions go so far as to state that the claims should essentially always be interpreted on their own merits, i.e. without consulting the description and figures at all (see T 675/22, Reasons 1.3; T 1924/20, Reasons 2.7; T 470/21, Reasons 2.1; T 2764/19, Reasons 3.1.1; T 1127/16, Reasons 2.6.1).
- 3.3.7 In the case at issue, the question cannot be left open since the claim language when read in isolation would not be considered ambiguous by the skilled person. Thus, when following the lines of case law that either do not allow for the description to be taken into consideration (see 3.3.6 above) or that allow for referring to the description only where claims are found to be ambiguous (see 3.3.1 and 3.3.2(a) above), the skilled person would be forced to ignore the existence of the definition of the term "gathered sheet" as given in paragraph [0035] of the description.
- 3.3.8 Therefore, whether the description and figures may be consulted when construing patent claims to assess patentability and whether this may be done generally or only if there are ambiguities in the claim language must be resolved.
- 3.4 The third point where the case law of the boards diverges is the extent to which definitions or similar information given in the description for certain terms may influence the interpretation of these terms when used in the claims. The following lines of case law can be detected.
- 3.4.1 Some decisions (see also points 3.4.4 and 3.4.5 below) emphasise the autonomy of patents to define the meaning of terms used in patent claims and the need to read these terms in the context of the whole content, taking

into account what is achieved by the invention. Thus, terms used in patent documents should be given their normal meaning in the relevant art unless the description gives the terms a special meaning. In that regard, the patent document may be its own dictionary. (See e.g. T 620/08, Reasons 3.8; T 1321/04, Reasons 2.3 and 2.4, referring to T 312/94; T 969/92; T 311/93 and T 523/00.) The EPC does not require that terms used in different patents always have the same meaning (see T 523/00, Reasons 2).

3.4.2 Other decisions refer to the need for legal certainty in the patent system and remind that it is the claims that primarily determine the subject-matter of the invention. Thus, many decisions underline that the support of the description should at least not be used for restricting or modifying the subject-matter of the invention beyond what a skilled person would understand when reading the wording of the claims (see e.g. T 169/20, Reasons 1.4). The majority of decisions seem to agree on this, many of which apply Article 69 and its protocol. The reasoning given for this in these cases is based on the wording of Article 69(1), first sentence and has become known in the recent years, following T 1473/19, Reasons 3.16., as the principle of the primacy of the claims (see e.g. T 450/20, Reasons 2.15).

3.4.3 However, there seems to be no common understanding on how to achieve this goal and where to draw the line.

(a) As mentioned above (see 3.3.6), some decisions postulate that the claims should always be construed on their own merits without taking anything from the description, including any definition found there, into account as a

"supplementary-guidance tool" (see e.g. T 1924/20, Reasons 2.7).

- (b) Decisions applying the principle of ambiguities as a prerequisite for claim construction (see 3.3.1 and 3.3.2(a) above) disregard information, including definitions, in the description if the claim read on its own is found to be clear (see e.g. T 197/10, Reasons 2.3; T 1266/19, Reasons 11.4).
- (c) Even where such a claim was found unclear, some decisions disregarded a definition or similar information found in the description if it might be used to restrict or modify the subject-matter of the invention beyond what a person skilled in the art would understand when reading the wording of the claims, for example, by excluding interpretations which are both reasonable and technically sensible within the relevant technical context (see e.g. T 169/20 Reasons 1.4; T 821/20 Reasons 1.7).
- (d) Among the decisions that always take the description into account, some disregard definitions and other information from the description only if they are found to contradict or be "not at all compatible with" the ordinary meaning of terms used in the claim (see e.g. T 1473/19, Reasons 3.16.2).
- (e) Other decisions, among those that are open to applying Article 69 and its protocol, draw the line where the description would be used to implicitly limit the meaning of features in the claim (see e.g. T 1844/19, Reasons 1.5). Thus, similar to the

cases referred to in (c) above, a contradiction or incompatibility would not be necessary to disregard definitions found in the description.

(f) Finally, several decisions hold that, at a stage of the proceedings where this is still possible, especially during examination but also in opposition proceedings, any mismatch between claims and a definition or the like in the description should be resolved by amending the claims since this is where the invention should be defined (see e.g. T 2589/11, Reasons 2.2 and T 768/08, Reasons 4.4, both referring to T 1279/04). Thus, where the definition is not included in the claim but could have been, it seems that these decisions would disregard it under similar conditions as the decisions referred to above under points (c), (e) and (f).

3.4.4 Moreover, as mentioned above in 3.4.1, not all decisions follow this restrictive approach. In T 299/09 (Reasons 3.3.1 b)), an interpretation of a term or feature on the basis of the description is declared to be feasible if this term or feature is given a different or extended definition in the description compared to what a person skilled in the art would normally understand by it. T 620/08, Reasons 3.8 (with reference to T 556/02, Reasons 5.3; T 416/87, Reasons 5, and T 500/01, Reasons 6), expressly states:

"Being a legal document a patent may be its own dictionary. It may define technical terms and determine how a skilled person has to understand a specific word when used in the description or the claims. Thus, the description may give a word or an expression, even an unequivocally clear one, which has a generally accepted

meaning, a different meaning than the generally accepted one by explicit definition."

3.4.5 One reason might be that the restrictive approach mentioned above under points 3.4.2 and 3.4.3 focuses on cases where a party attempted to narrow the meaning of a term used in a claim from a broader, ordinary understanding of the term to a more restricted definition explicitly found in the description or allegedly implied by it. However, there are also cases where taking into account a definition found in the description would lead to a broadened understanding compared to the ordinary meaning of the defined term. In these cases, the boards seemed to be more willing to construe the claim in light of the description (see e.g. T 694/20, Reasons 4.1 and 4.9 to 4.11; T 1283/16, Reasons 4 to 12; T 620/08, Reasons 3.8 to 3.17). The reason behind this seems to be, as stated in T 1671/09 (Reasons 3.3 and 3.4), that it is up to the patent proprietor whether the meaning of a term in the patent has been "deliberately broadened via the description" beyond the usual understanding in the relevant field.

3.4.6 However, this approach is not shared in all cases. In T 1385/14 (see Reasons 4.3 and 4.4), the competent board disregarded even a broad definition given in the description for the term "printed pattern" as used in the claims for the reason that this term was found to be unambiguous and to have a clear technical meaning. Therefore, it did "not need to be reinterpreted in the light of the description and drawings".

3.4.7 In the case at hand, the definition given in the description changes the meaning of the term "gathered sheet" as usually used in the field. However, the skilled person would not see it as contradicting the

ordinary meaning, which is based on the most common method for producing gathered sheets. The definition instead broadens this meaning and still makes technical sense. The term as defined by the description now includes all other potential methods for gathering tobacco sheets to give them the form of a cylindrical rod.

Thus, among the different approaches set out above under point 3.4.3, the line of case law under letter(d) would not disregard the definition in the description, whereas the ones under letters(a) and(b) would. Those referred to under letters(c) and(f) might do so under the assumption that they apply wherever a definition in the description modifies the claim language. Under the assumption that they, as the ones under letter(e), depend on the further condition that the modification is a limiting one, whether the definition should be taken into account hinges on which of the two lines of case law as set out under points 3.4.4/3.4.5 and 3.4.6, respectively, is to be followed.

3.4.8 To sum up, in any case and independent of the two other questions, the question whether and to what extent definitions and similar information found in the description may be disregarded must be answered before deciding the current case.

4. A decision of the Enlarged Board is also required because a point of law of fundamental importance arises since claim construction by the European Patent Office has to be seen within the greater context of the patent protection system as a whole.

4.1 Granting European patents is not an end in itself. Rather, the examining procedure (and any subsequent

opposition proceedings) are the hurdle set by the member states that must be overcome to obtain (in examination proceedings) and retain (in opposition proceedings) monopoly protection for the subject-matter of inventions that have been proven to be new, inventive and sufficiently disclosed.

4.1.1 The extent of protection conferred by a European patent is determined by the claims (Article 69 EPC), and the claims of an application define the subject-matter of the invention for which protection is sought (Article 84 EPC). Thus, it is the subject-matter of these claims defining the invention that is examined for sufficiency of disclosure, novelty and inventive step under Articles 83, 52, 54 and 56 EPC. As a consequence, it is of utmost importance that the subject-matter examined by the European Patent Office during grant and opposition proceedings be identical to the subject-matter taken as the basis for allowing monopoly protection by the national courts of the member states once the European patent is in force.

4.1.2 Otherwise, subject-matter of prior art can be taken as a reason to deny the grant of a European patent even though its scope of protection did not encompass such subject-matter. Or European patents are granted that give protection for subject-matter that was already known in or rendered obvious by the prior art. Both scenarios would be detrimental to either the well-acquired rights of applicants and patent proprietors or the freedom to operate in the public domain, respectively. Thus, everything seen as an apple after grant should only be compared with the apples in the state of the art, but everything that might turn out to be both an apple and an orange in the post-grant world should not only be compared to apples but also to

oranges during examining and opposition proceedings.

- 4.2 There is no doubt that Article 69 EPC and its protocol is to be applied to construe the meaning of the claims of a European patent once it is in force (see the overview on national case law given in decision T 367/20, Reasons 1.3.5). Thus, the question to be answered is whether an approach that uses a different basis for construing the meaning of the claims during grant proceedings (including examining and opposition proceedings) is able to achieve the goals as set out above under point 4.1.1.
- 4.3 A further question is whether the person skilled in the art must find a claim unclear to be able to take the description and figures into account when interpreting a claim to assess patentability. To the knowledge of the Board, no national jurisdiction of the member states of the European Patent Organisation answers this question in the affirmative. A look at the situation in some of the larger member states reveals the following picture.
- 4.3.1 Six decisions from the last ten years construing patent claims in France were reviewed, including five given by the Tribunal judiciaire (TJ) de Paris, the former Tribunal de grande instance (TGI) de Paris, (TGI Paris, 02.07.2015, N°RG 12/11488; TGI Paris, 14.04.2016, N°RG 14/11998; TGI Paris, 20.04.2017, N°RG 14/05016; TGI Paris, 16.11.2017, N°RG 14/14922; TJ Paris, 24.03.2023, N°RG 20/03907) and one by the Cour d'appel (CA) de Paris (CA Paris, 19.10.2021, N°RG 17/22624). All these decisions refer either to the need to interpret the claims in light of the description or at least do so when interpreting the claims. None states that the wording of the claim must be found ambiguous before

doing so.

- 4.3.2 Thirteen decisions of UK courts from the last 20 years dealing with claim construction have been reviewed, including 11 from the England and Wales High Court (EWHC) and one each from the England and Wales Court of Appeal (EWCA) and the House of Lords (now the Supreme Court of the United Kingdom). These decisions paint a similar picture to the French decisions. The need to read the claims in the context of the description and any drawings contained in the specification is often expressed and seems to be common practice in both the assessment of patentability and infringement.

Many decisions refer to the wording of Article 69 EPC and its protocol or the parallel provision in section 125(1) Patent Act 1977. They agree on the fundamental considerations on claim construction as laid down in the leading decisions *Kirin Amgen Inc v Hoechst Marion Roussel* [2004] UKHL 46, [2005] RPC 9, 21 October 2004, by the House of Lords and *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd* [2009] EWCA Civ 1062, [2010] RPC 8, 22 October 2009, by the EWCA. The latter states, in point 5, referring to the impugned decision [182](iv):

"It further follows that the claims must not be construed as if they stood alone - the drawings and description only being used to resolve any ambiguity."

- 4.3.3 There is a big body of case law from the German Bundesgerichtshof (Federal Supreme Court - BGH) confirming that this is also the settled opinion in Germany, both for the construction of European and German patents, be it for patentability or infringement (see e.g. BGH Urt. v. 29.06.2010 - X ZR 193/03 - BGHZ

186, 90 - Crimpwerkzeug III, point 13)).

In BGH, Urt. v. 12.05.2015 - X ZR 43/13 - Rotorelemente, point 15, the German Federal Supreme Court, referring to many of its earlier decisions, held that the construction of the patent claim, taking into account the description and figures, is always required and must not be omitted even if the wording of the claim appears to be unambiguous:

"Zu Recht rügt die Berufung, dass es das Patentgericht unterlassen hat, Patentanspruch 1 zunächst unter Heranziehung der Beschreibung und der Zeichnungen auszulegen..."

Nach der ständigen Rechtsprechung des Bundesgerichtshofs ist die Auslegung des Patentanspruchs stets geboten und darf auch dann nicht unterbleiben, wenn der Wortlaut des Anspruchs eindeutig zu sein scheint."

- 4.3.4 The Court of Appeal of the Unified Patent Court (CoA UPC) confirmed this case law developed by the national courts of European Patent Organisation member states, referring to one of the early decisions of the Enlarged Board of Appeal, mentioned above in point 3.2. On 26 February 2024, the CoA UPC held that, in accordance with Article 69 EPC and its protocol (see *Nanostring v 10x Genomics*, UPC_CoA_335/2023, App_576355/2023, Grounds for the Order at 4.d)aa)):

"The patent claim is not only the starting point, but the decisive basis for determining the protective scope of a European patent under Art. 69 EPC in conjunction with the Protocol on the Interpretation of Art. 69 EPC.

The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim.

However, this does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to what, after examination of the description and drawings, appears to be the subject-matter for which the patent proprietor seeks protection.

The patent claim is to be interpreted from the point of view of a person skilled in the art.

In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.

These principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent. This follows from the function of the patent claims, which under the European Patent Convention serve to define the scope of protection of the patent under Art. 69 EPC and thus the rights of the patent proprietor in the designated Contracting States under Art. 64 EPC, taking into account the conditions for patentability under Art. 52 to 57 EPC (see EPO EBA, 11 December 1989, G 2/88, OJ 1990, 93 para. 2.5)."

- 4.3.5 Beyond what courts of member states have ruled, it seems that the founders of the EPC themselves already answered the initial question (see 4.3) whether Article

69(1) EPC, second sentence ("*Nevertheless, the description and drawings shall be used to interpret the claims*") is to be read under the further proviso that in a first step the claim when read on its own has to be found unclear by adding the Protocol on the Interpretation of Article 69 EPC to the Convention, especially its first sentence. Article 1 reads (emphasis added by the Board):

*"Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, **the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims.** Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties."*

Lord Hoffmann in *Kirin Amgen Inc v Hoechst Marion Roussel* [2004] UKHL 46, [2005] RPC 9, 21 October 2004, explained:

"[27] It is impossible to understand what the first sentence of the Protocol was intending to prohibit without knowing what used to be the principles applied (at any rate in theory) by an English court construing a legal document. These required the words and grammar of a sentence to be given their 'natural and ordinary

*meaning', that is to say, the meanings assigned to the words by a dictionary and to the syntax by a grammar. This meaning was to be adopted regardless of the context or background against which the words were used, unless they were 'ambiguous', that is to say, capable of having more than one meaning. As Lord Porter said in *Electric & Musical Industries Ltd v Lissen Ltd* (1938) 56 RPC 23, 57:*

'If the Claims have a plain meaning in themselves [emphasis supplied], then advantage cannot be taken of the language used in the body of the Specification to make them mean something different.'

[28] On the other hand, if the language of the claim 'in itself' was ambiguous, capable of having more than one meaning, the court could have regard to the context provided by the specification and drawings. [...]"

Without knowing that this quote is in fact a historic view on the older English case law, it could easily be taken as an adequate description of what a big part of the current case law of the boards still expresses.

Lord Hoffmann concluded:

"[29]. [...] Indeed, the attempt to treat the words of the claim as having meanings 'in themselves' and without regard to the context in which or the purpose for which they were used was always a highly artificial exercise.

[30] It seems to me clear that the Protocol, with its reference to 'resolving an ambiguity', was intended to reject these artificial English rules for the

construction of patent claims. [...]"

4.4 If the construction of patent claims during grant proceedings and for the validity and enforcement of patents after grant are considered two sides of the same coin, it is also of fundamental importance to have a harmonised view on the use of definitions or similar information found in the description when construing patent claims and on the limits of such use.

4.4.1 The case law in France accepts that the patent, notably its description, may serve as a patent's own dictionary (see e.g. TGI Paris, 20.04.2017, N° 14/05016, point 1 a) of the Reasons).

"Les critères définis dans le Protocole interprétatif de l'article 69 de la Convention sont appliqués mutadis mutandis au brevet français : ... Est recherchée lors de l'interprétation des revendications quand celle-ci est nécessaire une position qui assure à la fois une protection équitable au titulaire du brevet et un degré raisonnable de sécurité juridique aux tiers. Le brevet doit dans ce cadre contenir en lui-même son propre dictionnaire, notamment au stade de la description."

However, no decision has been found where the patent claim was construed on its own merits to decide whether a definition in the description might have to be disregarded due to a potential divergence compared to this meaning.

4.4.2 The two leading cases in UK case law (see 4.3.2 above) give guidance on how to determine the meaning of words used in a patent specification in the UK.

The meaning is to be determined objectively against the

background of the common general knowledge of a skilled person in the relevant field, being the addressee of a patent specification, and with regard to the purpose for which the words are used. Thus, the meaning is dependent on the context in which the words are used (see *Kirin Amgen v Hoechst Marion Roussel* [2004] UKHL 46, [2005] RPC 9, 21 October 2004, points 32 to 35, where Lord Hoffmann explained (in point 33, citing an earlier decision): "*A person may be taken to mean something different when he uses words for one purpose from what he would be taken to mean if he was using them for another*").

This reasoning is summarised in the *Virgin Atlantic v Premium Aircraft* [2009] EWCA Civ 1062, [2010] RPC 8, 22 October 2009, in point 5, referring to the impugned decision, a passage often cited in other decisions, as follows (emphasis added by the Board):

"(i) The first overarching principle is that contained in Article 69 of the European Patent Convention;

(ii) Article 69 says that the extent of protection is determined by the claims. It goes on to say that the description and drawings shall be used to interpret the claims. In short the claims are to be construed in context.

(iii) It follows that the claims are to be construed purposively the inventor's purpose being ascertained from the description and drawings.

[...]

(vii) It follows that if the patentee has included what is obviously a deliberate limitation in his claims, it must have a meaning. One cannot disregard obviously intentional elements.

(vii) It also follows that where a patentee has used a word or phrase which, acontextually, might have a particular meaning (narrow or wide) it does not necessarily have that meaning in context.
[...]"

In this decision, dealing with a sleeping seat configuration of an aircraft, the proprietor argued that its claim was limited to a special seat configuration (a flip-over-seat). The court of appeal did not accept this, referring, *inter alia*, to the fact that the claim language was identical to the "consistorial clause" in the general part of the description, save for the additional explanation given there: "(Seating system of the type disclosed e.g. in [the BA application])". Since the BA application did not contain a flip-over-seat, the skilled person would not interpret the claim to be restricted to this kind of seat (see points 39 and 56). Thus, the indirect definition consisting of the consistorial clause pointing to a certain seat configuration in the prior art was taken into account, however, together with the fact that the claim language itself did not hint at the alleged limitation (see points 51 to 54).

The fact that definitions found in the description for terms in the claim are normally not disregarded can also be deduced from the decision *McGhan Medical UK Ltd v Nagor Ltd and Biosil Ltd* [2001] EWHC Patents 452, 28 February 2001, which (see point 101) indicated to have "used the definition of the word 'foam' given in the patent".

4.4.3 The principle of the patent being its own dictionary is also accepted and widely used in the case law of the

German Federal Supreme Court since BGH, Urt. v. 02.03.1999 - X ZR 85/96 - Spannschraube, Reasons 3 c). See e.g. BGH, Urt. v. 07.07.2015 - X ZR 64/13 - Bitratenreduktion, point 13, where the court held that the fact that the claims are given primacy in case of a contradiction between the claim language and the description does not exclude that a claim when read in the context of the description and figures may have a meaning that diverges from the meaning of the claim when read in isolation. Thus, when in doubt, a claim is to be understood in a way that does not render both parts of the patent specification contradictory. Only when this is not possible may no conclusion be drawn from these parts of the description on the protected subject-matter (see Reasons 4.bb)):

"Die Beschreibung des Patents kann Begriffe eigenständig definieren und insoweit ein "patenteigenes Lexikon" darstellen. Auch der Grundsatz, dass bei Widersprüchen zwischen Anspruch und Beschreibung der Anspruch Vorrang genießt, weil dieser und nicht die Beschreibung den geschützten Gegenstand definiert und damit auch begrenzt, schließt nicht aus, dass sich aus der Beschreibung und den Zeichnungen ein Verständnis des Patentanspruchs ergibt, das von demjenigen abweicht, das der bloße Wortlaut des Anspruchs vermittelt. Funktion der Beschreibung ist es, die geschützte Erfindung zu erläutern. Im Zweifel ist daher ein Verständnis der Beschreibung und des Anspruchs geboten, das beide Teile der Patentschrift nicht in Widerspruch zueinander bringt, sondern sie als aufeinander bezogene Teile der dem Fachmann mit dem Patent zur Verfügung gestellten technischen Lehre als eines sinnvollen Ganzen versteht. Nur wenn und soweit dies nicht möglich ist, ist der Schluss gerechtfertigt, dass aus Teilen der Beschreibung keine

Schlussfolgerungen in Bezug auf den geschützten Gegenstand gezogen werden dürfen.

Similar: BGH, Urt. v. 12.05.2015 - X ZR 43/13 - Rotor-elemente, point 16, Reasons III.1., also citing many earlier decisions

4.4.4 In its latest decision, *VusionGroup v Hanshow* (APL_8/2024, ORD_17447/2024) of 13 May 2024, the CoA UPC confirmed the guidelines given in *Nanostring v 10x Genomics* (UPC_CoA_335/2023, App_576355/2023) (see 4.3.4 above).

In the earlier decision (see Grounds for the Order 4 d) bb) and cc)), the CoA UPC referred to the wording of the claim and the information given in the description to construe various features of the claim. The Court found an interpretation of the claim that was supported by the information in the description and did not accept an argument of the patent proprietors based on a rather narrow interpretation of a passage in the description.

In the latest decision, the CoA UPC first emphasised that the features of a claim had to be read in combination (see Grounds for the Order in point 29) and then again took the information of several passages of the description as a basis to construe the three relevant claim features (see points 30 to 32). It again rejected arguments of the proprietor and argued taking into account the wording of the claim and information found in the description and one of the figures (see points 33 to 36). The CoA UPC concluded, in point 37:

"The interpretation of claim feature 8.4 given above is based on the wording of the claim, read in the light of

the description and drawings from the perspective of a person skilled in the art based on their common general knowledge, without having regard to the prosecution history of the patent."

Neither case contained any passage disregarding parts of the description. The information in the description was taken into account even though it did not contain any explicit definition.

5. Thus, to come to a decision in the case at hand, the following three questions must first be answered, both to ensure the uniform application of the law and because a point of law of fundamental importance arises.
 - 5.1 Is Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?
 - 5.2 May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?
 - 5.3 May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions?
6. It seems desirable to come to a common understanding on these questions neither by developing totally new

standards nor by looking at national law alone but rather also by building on the case law of the boards developed over the last 40 years.

- 6.1 The CoA UPC has taken the first step in this direction by referring to the original case law developed by the Enlarged Board of Appeal of the European Patent Office in the days when the Enlarged Board had no doubt that Article 69 EPC and its protocol were applicable also when assessing patentability (see 3.2 and 4.3.4 above).
- 6.2 Should the Enlarged Board of Appeal reiterate this position, it seems that the rationale behind the main lines of case law of the boards could still be applied. However, the order of legal examination might change. The resulting practice might be equally suitable to adequately deal with both narrowing and broadening definitions found in the description. A closer look at the reasons behind the development of the case law may render this plausible.
 - 6.2.1 As a granting authority dealing with almost 200 000 patent applications per year, the European Patent Office has a need to apply a robust, harmonised and predictable examination scheme. Furthermore, it is of utmost importance, as laid down in Article 84 EPC, that the claims, defining the matter for which protection is sought, be clear, concise and supported by the description. Thus, using known terms to describe something that does not correspond to the established meaning of such terms is a potential threat to the clarity of a claim.

This may not always be avoidable, as Lord Hoffmann put it in *Kirin Amgen Inc v Hoechst Marion Roussel* [2004] UKHL 46, [2005] RPC 9, 21 October 2004, in point 34:

"It must be recognised that the patentee is trying to describe something which, at any rate in his opinion, is new; which has not existed before and of which there may be no generally accepted definition. There will be occasions upon which it will be obvious to the skilled man that the patentee must in some respect have departed from conventional use of language [...]"

However, as Lord Hoffmann concluded:

"[...] one would not expect that to happen very often."

If it does happen, one might add, it is in the interest of legal certainty that the alternative meaning of the term be made apparent in the context of the claim itself. It is not so rare that any divergence would not be noticed by both the applicant and the examining division (for instance, because the focus in examining proceedings did not lie on that term) and come to light only during opposition proceedings. Also in these cases, although Article 84 is not directly applicable where the lack of clarity is not caused by an amendment, the boards felt a need not to sweep under the carpet that there is an ordinary meaning of the term and, thus, a certain probability that the skilled person reading the claim will give the term that known meaning. If patent proprietors are not willing to embed that alternative meaning directly in the wording of the claim although they could, they should not profit from alternative understandings based only on information in the description or the drawings.

6.2.2 These may be the reasons (expressed e.g. in T 1628/21, Reasons 1.1.18) for developing both the principle of

"the description may only be consulted in case of ambiguities in the claim" (see above at point 3.3) and the principle of "the claims should always be construed on their own merits" (see above at point 3.3.6).

6.2.3 However, it does not seem to be necessary to totally disregard the description (because the claim language contains only terms with known meanings as in the first principle or under all circumstances as in the second principle) to achieve this aim.

To the contrary, also when the term in the claim is in a first step regarded in the context of all the information given in the other features, the other claims, the description and the drawings as suggested by Article 69 (1), second sentence and its protocol, the fact that patent proprietors apparently willingly refrained from including information from the description and drawings that give the term an alternative meaning compared to the one ordinarily linked to it may be taken into account for the following reason. In that case, there is still the risk that the skilled person reading the patent and giving considerable weight to the claims as the place where the invention is defined and the extent of protection conferred by the patent is determined might understand the term in its ordinary meaning.

This may be a good reason to construe the patent when in doubt in a way that the term used in the claim is understood in a broad sense, such as to include both potential meanings. Thus, where the information giving the terms in the claims the meaning as intended in the patent is not included in the claims even though it could have been by amendment of the claims, the share of prior art examined that is potentially novelty-

destroying or could render an invention obvious is increased during examination and opposition proceedings.

- 6.2.4 This approach would be in line with Article 69 EPC and its protocol and would not prevent a board from giving a term in a claim that has a narrower ordinary meaning than the one apparently intended in the context of the description and drawings the broader meaning resulting from the patent specification as a whole.

Thus, the two principles mentioned above in point 6.2.2 not only seem to be unnecessary to prevent applicants or patent proprietors from reading restrictive features into the claim based solely on the description or the drawings, they may also be detrimental to legal certainty when during examination and opposition, based on these principles, the claim would need to be interpreted more narrowly than it will be read after grant, see Professor Franzosi's famous angora cat analogy as referred to in *European Central Bank v DSS* [2008] EWCA Civ 192, 19 March 2008, point 5.

To disregard all the information in the description and the drawings on how a term used in a claim apparently was meant to be understood might also expose a board to the accusation that the patent is construed with a mind desirous of misunderstanding, this being counter to a central principle of claim construction in the case law of the boards since T 190/99 (Reasons 2.4):

"The skilled person when considering a claim should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity i.e. building up rather than tearing down, to arrive at an interpretation of the

claim which is technically sensible and takes into account the whole disclosure of the patent (Article 69 EPC). The patent must be construed by a mind willing to understand not a mind desirous of misunderstanding."

- 6.2.5 However, the aim of the two principles is a reasonable and valuable one that should be preserved both in the interest of legal certainty and the functioning of the European Patent Office as a granting authority (see 6.2.1 above). This seems to be possible as set out above in 6.2.3. However, it might require a reversal of the order of legal examination. First, the meaning of a term is determined in the context of the claims, description and drawings. Second, whether this meaning is sufficiently reflected in the claim is double-checked. If it is found not to be sufficiently reflected in the claim, a broader understanding encompassing all potential understandings derivable from the claim wording might be indicated.
- 6.3 On this basis, to what extent a definition or the like given in the description may be disregarded would also seem to be a less critical question.
- 6.3.1 Definitions or similar information narrowing the meaning of a term will, when only contained in the description, often not suffice to totally override the ordinary meaning of the term used in the claim. On the other hand, broadening definitions and the like in the description may be a clear signal that the term used in the claim may not only be understood in the conventional way but also in the broader sense set out in the description.
- 6.3.2 In both cases, it would be up to the patent proprietor to correlate the wording of the claims and the content

of the description to make it clear what invention is actually claimed. Where this is not done, another fundamental principle of claim interpretation, also common in national decisions, can be applied that any understanding of the claim wording which is technically reasonable should not normally be excluded by the claim (see e.g. T 1628/21, Reasons 1.1.2; BGH, Urt. v. 12.12.2006 - X ZR 131/02 - Schussfädentransport, point 17, Reasons III.4; along similar lines: *Samsung Electronics Co. Ltd v Apple Retail UK Ltd & Anor* [2013] EWHC 467 (Pat), 7 March 2013, points 67, 68 and 79). Where a patent specification contains a definition or the like of a term used in the claim, this may be seen as a clear indication that even the patent proprietor considered the meaning according to that definition to be (at least also) encompassed by the meaning of this term.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal for decision.

1. Is Article 69 (1), second sentence EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied on the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?

2. May the description and figures be consulted when interpreting the claims to assess patentability and, if

so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?

3. May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions?

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated